

REMARKS

Claims 1 - 20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 103(a) Rejections:

The Examiner rejected claims 1-3, 8, 12-15 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Parcel Insurance Plan (www.pipinsure.com) (hereinafter “PIPinsure”) in view of Keuper (DE 44 46 203 A1) (hereinafter “Keuper”), claims 4, 6, 9 and 19 as being unpatentable over PIPinsure and Keuper and further in view of Kadaba et al. (U.S. Patent 6,285,916) (hereinafter “Kadaba”), claims 5, 7, 10 and 11 as being unpatentable over PIPinsure and Keuper and further in view of Official Notice, claim 16 as being unpatentable over PIPinsure and Keuper and further in view of eBay, claim 17 as being unpatentable over PIPinsure and Keuper and further in view of Chen et al. (U.S. Patent 5,504,674) (hereinafter “Chen”) and further in view of knowledge generally available to one having ordinary skill in the art, and claim 18 as being unpatentable over PIPinsure and Keuper and further in view of Kepler (U.S. Patent 5,347,845). Applicant respectfully traverses these rejections for at least the following reasons.

In regard to claim 1, contrary to the Examiner’s assertion, the combination of cited art fails to teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, receiving a request to insure the item being shipped from an origination to a final destination. The Examiner cites page 8 of PIPinsure that includes a form to request a savings quote. Clearly, a request *for a savings quote* is not a request *to insure a particular item that is actually being shipped*. PIPinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user’s shipping *habits* including *average* number of packages insured per day and *average* value per insured package. Thus, instead of a specific package, the form addresses packages in the aggregate on average. A request for a saving quote regarding aggregated average

shipments over days or months cannot be considered a request to insure a particular item being shipped from an origination to a final destination. Additionally, a business typically provides a *quote* to help facilitate a customer's decision on whether to order a service or product. Thus, a *quote* is requested *before* a customer actually decides whether to request a given service or product. Furthermore, PIPinsure fails to disclose an origination or a final destination for a specific item. Thus, for numerous reasons, PIPinsure clearly does not teach or suggest receiving a request to insure the item being shipped from an origination to a final destination.

Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel, such as identification, filling date, beer grade, etc. Keuper has nothing to do with a request to insure an item. Thus, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest a request to insure an item being shipped from an origination to a final destination.

In the Response to Arguments, the Examiner "disagrees with Applicant's PIPinsure interpretation, which appears to be have been done in a vacuum." However, the Examiner's response is based solely and completely on the Examiner own speculation unsupported by any **evidence of record**. For instance, the Examiner first argues that PIPinsure's "request for a saving quote is inherently a request to insure an item" and that "broadly and reasonably speaking, a request for a savings quote is a tacit request to insure an item, irrespective whether the request is consummated." The Examiner provides not evidence in support of these broad, conclusory statements of opinion. Moreover, the Examiner's assertion is simply not correct and is not supported by the actual disclosure of the PIPinsure reference. As discussed above, PIPinsure only discusses a *savings* quote based on *general characteristics* of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. Nowhere does PIPinsure describe receiving a request to insure a particular item actually being shipped from an origination to a final destination. Applicant's assertions are not made "in a vacuum". Instead, Applicant's assertions are made based on the explicit teachings of the evidence of record.

Secondly, Examiner states, “a skilled artisan in the insurance and parcel shipping arts would easily glean from the complete PIPinsure teachings that a request to insure an item is taught and suggested by the PIPinsure reference.” However, the Examiner’s assertion not supported by the actual teachings of the reference. PIPinsure clearly only discusses shipping quotes based on average/aggregate shipping *habits*. PIPinsure does not discussing receiving a request to insure any particular item that is actually being shipped. The Examiner has not provided any evidence to support the conclusion that one skilled in the art would recognize receiving a request to insure an item as inherently included in PIPinsure’s system.

Thirdly, the Examiner argues, “Applicant was not the first to invent the concept of insuring items to be shipped from an origination to a final destination.” However, Applicant has never made any such argument. Moreover, Applicant’s claim does not recite merely the general concept of insuring items to be shipped from an origination to a final destination. Instead, Applicant’s claim recites a specific method including the specific limitation of receiving a request to insure the item being shipped from an origination to a final destination *in combination with* other limitations. Applicant asserts that this limitation *in combination with* the other limitations of Applicant’s claim is not taught by the cited art. Applicant respectfully reminds the Examiner that it is the Examiner who shoulders the burden of proof to establish a *prima facie* rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Applicant also strongly objects to the Examiner rejecting Applicants’ claims based on the “gist” of Applicants’ claim. M.P.E.P states at §2141, “the claimed invention must be considered as a whole.” As stated in M.P.E.P at §2141.02, it is clearly improper to distill an invention down to the “gist” or “thrust”. Specifically, “distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter as a whole.” That is exactly the situation with the Examiner’s rejection. The Examiner argues that “Applicant was not the first to invent the concept of insuring items to be shipped from an origination to a final destination.” The Examiner is clearly ignoring the specific limitations recited in Applicants’ claim and is instead rejecting

Applicants' claim based on the Examiner's opinion that Applicants were not "the first to invent the concept of insuring items to be shipped from an origination to a final destination." The Examiner has clearly distilled Applicants' invention down to a 'gist' or 'thrust'. Thus, the Examiner's basis for rejection is improper.

While the "express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims," "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" (M.P.E.P. §2112, "Examiner must provide rationale or evidence tending to show inherency") and "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." The Examiner's rejection appears to be based on the Examiner's opinion, unsupported by evidence, that "receiving a request to insure an item being shipped from an origination to a final destination" is inherent in PIPinsure. However, PIPinsure's saving quote is simply a free quote estimating the *amount of savings* a *potential* customer may obtain by using the PIPinsure service. How PIPinsure would provide actual insurance for any given item is described in the cited reference. For example, even if actual insurance was provided, the PIPinsure system might provide insurance on a bulk, aggregate or average basis. Thus, there is no requirement that the PIPinsure system would ever have to receive a request to insure a particular item being shipped from a particular origination to a particular destination. The Examiner's speculation, unsupported by evidence or technical reasoning, does not change the fact that, contrary to the Examiner's contention, PIPinsure's saving quote, even if combined with the Examiner's other cited art, does not inherently include, teach or suggest *receiving a request to insure an item being shipped from an origination to a final destination*. Thus, the Examiner's rejection is clearly improper.

The Examiner further states, "PIPinsure is not in the business of merely providing savings quotes; rather, PIPinsure is in the business of insuring parcels (i.e., items to be shipped)" and that "a skilled artisan in the insurance and parcel shipping arts would easily

glean from the complete PIPinsure teachings that a request to insure an item is taught and suggested by the PIPinsure reference.” However, regardless of any additional business or services that the Examiner believes may be provided by PIPinsure, the issue at hand is whether the PIPinsure reference cited by the Examiner (the actual evidence of record) teaches or suggest the specific limitation relied on by the Examiner, which Applicants’ argue it does not. As noted above, even if actual insurance was provided, the PIPinsure system might provide insurance on a bulk, aggregate or average basis. Thus, there is no requirement that the PIPinsure system would ever have to receive a request to insure a particular item being shipped from a particular origination to a particular destination. The Examiner’s reliance on PIPinsure, whether considered singly or in combination with the Examiner’s other cited art, to teach or suggest (either explicitly, implicitly, or inherently) *receiving a request to insure the item being shipped from an origination to a final destination* is clearly misplaced.

Additionally, the Examiner’s citing of page 18 of PIPinsure regarding an origination and destination has nothing whatsoever to do with either a request to insure an item being shipped from an origination to a final destination or PIPinsure’s request for saving quote. Instead, at page 18, cited by the Examiner to support the erroneous contention that PIPinsure includes “insuring parcels (i.e., items) from an origination to a final destination”, PIPinsure compares the cost of shipping items via expedited services (such as overnight shipping) to the cost of slower forms of shipping (such as standard ground shipping). Page 18 has nothing to with insuring parcels and clearly fails to teach or suggest, even if combined with the Examiner’s other cited art, anything regarding receiving a request to insure an item being shipped from an origination to a final destination.

Furthermore, this particular argument by the Examiner is irrelevant. Applicants’ have never argued that PIPinsure could not insure items or that items can not be shipped from an origination to a final destination. Instead, as noted above, Applicant argues that PIPinsure, even if combined with the Examiner’s other cited art, does not teach or

suggest the specific limitation of receiving a request to insure a particular item being shipped from a particular origination to a particular final destination.

The Examiner also argues that “applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” However, Applicants did not argue against the references individually. For instance, at page 8, lines 6-10 of Applicants previous response (filed October 19, 2006) clearly demonstrate that Applicants arguments were (and are) directed against the Examiner’s combination of cited art. In fact, when arguing that the Examiner’s reliance on PIPinsure is misplaced, Applicants clearly state, “PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest a request to insure an item being shipped from an origination to a final destination.” Moreover, any argument regarding an individual reference is intended to show that the Examiner’s reliance on that reference is misplaced. Thus, the Examiner’s statement regarding Applicants arguing against the references individually is incorrect.

Further in regard to claim 1, the Examiner’s combination of cited art also fails to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. The Examiner asserts PIPinsure discloses this limitation on page 1. However, page 1 of PIPinsure merely discloses a simple table of annual potential savings dependent on a declared package value and number of shipments per day. *A table of potential savings* is not the same as searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the particular item. In fact, a table of potential savings on a web page is completely different than searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. Thus, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item.

In the Response to Arguments, the Examiner again responds to Applicant's arguments by citing page 18 of PIPinsure. However as noted above, page 18 of PIPinsure has nothing to do with *insuring* an item. Instead, page 18 compares the cost of expedited shipping over regular shipping. Nothing about the table illustrated on page 18 has anything whatsoever to do with *insuring* an item or about searching a database for a cost effective insurance. Thus the Examiner's contention the table on page 18 somehow teaches or suggests searching a database for a cost effective insurance that provides a specified level of insurance coverage for a particular item is clearly erroneous.

Without providing any actual evidence, the Examiner also provides his own speculation that the United States Postal Service, Federal Express, United Parcel Service, etc, "developed and used" "the concept of searching insurance databases having specified levels of insurance coverage for items" "well prior to Applicant's claimed invention." However, once again, the Examiner is rejecting Applicants' claim based solely on the Examiner's own speculation regarding the specific functionality of shipping services (e.g., USPS, FedEx, UPS, etc) "well prior to Applicant's claimed invention." If the Examiner intends to rely the United States Postal Service, Federal Express and/or United Parcel Service as prior art, Applicants respectfully request the Examiner provide a proper prior art reference that clearly demonstrates that one or more of these services included searching a database for a cost effective insurance that provides a specified level of *insurance* coverage for the particular item. Moreover, it again appears that the Examiner is again attempting to boil Applicant's claim down to a "gist" of the invention. As discussed above, this is not a proper basis for rejection.

Further regarding claim 1, the cited art fails to teach or suggest generating a data file comprising at least item information and insurer information. The Examiner cites page 8 of PIPinsure that discloses a form to request a savings quote. As described above, the form includes text fields to allow a user to enter answers to questions pertaining to a user's aggregated shipping habits. However, a form on a web page that allows users to request a savings quote is not the same as generating a data file comprising at least item information and insurer information. As discussed above,

PIPinsure discloses a series of questions that pertain to general characteristics of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. However, *insurer information* is not disclosed in any of the questions presented in the savings quote form of PIPinsure. Moreover, PIPinsure makes no mention of generating any data file. The mere existence of a web form for requesting a saving quote regarding a user's aggregated shipping habits does not imply the generation of a file including specific item information and insurer information. Clearly, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest generating a data file comprising at least item information and insurer information.

Once again, the Examiner's response to Applicant's argument is merely speculation unsupported by any evidence or technical reasoning. Specifically, the Examiner restates the unsupported assertion that "PIPinsure does indeed teach and suggest generating a data file comprising at least item information and insurer information." The Examiner then states, again without any supporting evidence or technical reasoning, that "those of ordinary skill in the art are well aware of this technique that was developed as used well prior to Applicants' claimed invention", making reference to United States Postal Service, Federal Express, United Parcel Service, etc. However, the Examiner's unsupported speculations do refute Applicant's argument as to the **actual teachings of the evidence of record**, namely that the discussion of PIPinsure's savings quote at page 8 (as cited by the Examiner) does not teach, suggest or mention, even if combined with the Examiner's other cited art, generating a data file including at least item information and insurer information. Instead, The Examiner appears to arguing that the mere existence of a WEB-base entry form somehow inherently includes generating a data file including at least item information and insurer information, as recited in Applicants' claim. However, as noted above, it is well established that mere statements of conclusion or opinion are not sufficient for a proper rejection. Instead, the Examiner must provide evidence or technical reasoning to show that the characteristic relied upon, in this case generating a data file including at least item information and insurer information, is necessarily present in the reference. Such is not the situation in the present case. Here, the Examiner has merely stated that the

combination of cited art teaches and suggests generating such a data file without providing any evidence or technical reasoning.

Additionally in regard to claim 1, the cited art fails to teach or suggest storing the data file, containing both item information and insurer information, in a memory device that accompanies the item. The Examiner admits that PIPinsure fails to disclose this limitation and relies on Keuper to disclose storing the data file in a memory device that accompanies the item. As noted above, Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel. Keuper describes on page 8, lines 3-11:

This problem is solved in the following manner: during (or after) the filling of the barrel, filling data, such as the filling date and identification concerning the type of fluid charged in such as the beer grade, the filling volume, a sequential filling number, etc. are transmitted from the transmitting/receiving device to the transponder and are there stored as data set in a poll able manner is [sic] such a way that the data even at a later point in time cannot only be read out elsewhere but can also be updated.

As shown above, the data stored in Keuper's barrel tag transponder pertains to a barrel's contents. **The data stored in Keuper's barrel tag transponder does not include insurer information.** In fact, information such as the filling data disclosed by Keuper has absolutely nothing to do with insurer information. Furthermore, as argued above, PIPinsure fails to teach or suggest a data file containing both item information and insurer information. Thus, neither Keuper nor PIPinsure, taken singly or in combination, teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

In the response to arguments, the Examiner argues that "PIPinsure teaches insurer information" and that "Keuper teaches storing data files in memory devices that accompany an item." However, nothing in either PIPinsure or Keuper, even if considered in combination, teaches or suggests storing insurer information in a data file in a memory device that accompanies the item. The PIPinsure reference, as argued above, does not

teach or suggest, even if combined with Keuper, insurer information that would accompany an item, as in Applicants' claim. Instead, PIPinsure merely describes general savings information, such as an estimate of insurance savings that a potential customer may expect. Nor does Keuper teach storing the data file, containing item information and insurer information, in a memory device that accompanies the item. Thus, whether considered singly or in combination, PIPinsure and Keuper do not teach or suggest storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

Furthermore, the Examiner has failed to provide a proper reason for combining the teaching of PIPinsure with the teachings of Keuper. The Examiner asserts: "One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of PIPinsure with the motivation of acquiring shipment-handling data on an item." However, PIPinsure teaches relying on the shipment carrier to maintain shipment-handling data for a particular item. For instance, PIPinsure teaches that prior to filing a claim with PIPinsure, a user should "[f]ile a tracer with the carrier without delay when a package is lost" and a copy of the carrier's tracer form is a required document when filing a claim (PIPinsure, page 5). Thus, one of ordinary skill in the art would not be motivated to modify the teachings of PIPinsure to include the "keg tag" of Keuper to acquire shipment-handling data on an item because PIPinsure already utilizes a specific method of acquiring shipment-handling data – namely relying upon the independent shipping carriers to track shipments. One of ordinary skill in the art would simply use the teachings of PIPinsure to acquire shipment-handling data on an item. Moreover, "acquiring shipment-handling data on an item" provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item.

In the Response to Arguments, the Examiner merely states, "Examiner respectfully submits that the motivations to combine the references used throughout this rejection are adequate. However, stating the Examiner's opinion that the motivations are adequate fails to address Applicant's specific arguments regarding the fact that there is no

reason why one of ordinary skill would modify the teachings of PIPinsure and Keuper, as required by the Examiner's rejection. For instance, Applicants have argued that the Examiner's stated reason, namely that of "acquiring shipment-handling data on an item" is not adequate for various reasons, such as because PIPinsure already describes a perfectly reasonable method for acquiring shipment-handling data. Moreover, "acquiring shipment-handling data on an item" provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item. Thus, rather than providing a proper reason to modify the cited art, the Examiner has merely stated the Examiner's opinion, unsupported by any explanation or evidence, that the reasons are adequate. The Examiner has clearly failed to meet the burden of establishing a *prima facie* obviousness rejection.

Additionally, it would not make sense to modify PIPinsure to use the keg tags of Keuper. Since, as noted above, PIPinsure provides insurance for packages shipped using independent carriers, such as Airborne Express, DHL, FedEx, UPS, and the U.S. Postal Service, among others. Thus, the packages being insured never actually pass through a PIPinsure facility. In order to use the keg tags of Keuper, PIPinsure would have to receive each item, attach Keuper keg tag storing a data file including both item identification and insurer information, and then ship the package via the appropriate carrier. Clearly, such a process is not described by the references. Nor does it make sense to modify PIPinsure as suggested by the Examiner. The Examiner has failed to rebut these arguments in his Response to Arguments.

Moreover, for at least the reasons given above, even if the references were combined, such a combination would not result in Applicant's claimed invention. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. For the numerous reasons discussed above, the cited art clearly does not teach or suggest all limitations combined as recited in the currently pending claims.

Thus, the rejection of claim 1 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 5, the cited art fails to teach or suggest the method of claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses. Furthermore, the Examiner takes official notice that “it is old and well know within the computer arts to transmit information via a network to an email address.” Pursuant to M.P.E.P. § 2144.03, Applicant previously traversed the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant assert that it was not well known in the prior art to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses, *in the specific context of Applicants’ invention*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, disclose a generating a data file with item information and insurer information much less forwarding copies of that type of data file via the network to one or more predetermined email addresses. Pursuant to M.P.E.P. § 2144.03 Applicant asserted in the previous response that the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner, in the Response to Arguments, fails to provide any documentary evidence while still maintaining the rejection. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known *in the context of Applicants’ invention* to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses. **Furthermore, Applicant’s claim does not recite merely transmitting information via a network to an email address.** Instead, claim 5 requires that copies of a specific data file that is also stored in a

memory device that accompanies the item being shipped are forwarded to one or more predetermined email addresses. This *specific limitation* is not disclosed by any evidence of record. Even if general prior art email transmissions referred to by the Examiner we combined with PIPinsure and Keuper, it would not suggest the specific limitation recited in claim 5. Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice.

Thus for at least the reasons presented above, the rejection of claim 5 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 6, the cited art fails to teach or suggest the method of claim 1 further comprising forwarding a copy of the data file via a network to a central server. The Examiner admits PIPinsure fails to disclose this limitation. The Examiner relies on Keuper and Kadaba to disclose forwarding a copy of the data file via a network to a central server. The Examiner cites Kadaba. Kadaba discloses (column 2, lines 30-54):

Generally described, the present invention provides an electronic parcel tracking system for use by an organization, comprising an intelligent hand-held, portable data entry and data processing device, which includes a wand-mounted symbol reader, a data entry and display screen capable of receiving and displaying information, including signature information, input by contact with the screen, an information storage device, a data transfer device, and a processor connected to the reader, the screen, the storage device, and the data transfer device. The processor is configured to associate and store in the information storage device data related to a particular parcel, including symbol information read by the reader, signature information acquired by the screen, and keyed information acquired by the screen, and to respond to queries about the particular parcel entered via the screen by displaying the data associated with the parcel.

Preferably, the data transfer device is selectively operable to transfer information from the information storage device to a personal computer system located at a parcel receiving location of the organization. Also, the portable data entry device may be equipped with a modem for transferring information related to a particular parcel between the information storage device and a central computer system located at a parcel delivery firm. (emphasis added)

Clearly, Kadaba fails to disclose, in the cited art or elsewhere, a data file comprising insurer information. Instead, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Furthermore, neither PIPinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a data file comprising insurer information. The Examiner's combination of cited art fails to teach or suggest forwarding a copy of the data file via a network to a central server, wherein the data file comprises insurer information.

In the Response to Arguments, the Examiner argues that since the physical structure of Keuper and Kadaba's system is capable of forwarding a (any) data file to a central server, the combination or prior art therefore teaches the specific limitation of forwarding a copy of data file that includes item information and insurer information that accompanies an item to a central server, as recited in Applicants' claim. The Examiner's argument regarding a "recitation of intended use" and "structural differences" is irrelevant to Applicants' specific *method* claim limitation. Claim 6 does not recite an intended use of a physical structure. Instead, Claim 6 recites a specific method limitation of *copying* a specific data file, generated as recited in claim 1, to central server via a network. As noted above, the Examiner's combination of cited art does not teach or suggest the specific method limitation recited in claim 6. Whether or not a system resulting from the Examiner's combination of cited art would or would not be capable of copying such a data file via a network to a central server is irrelevant to the fact that the combination of cited art fails to teach or suggest such a limitation. Moreover, the Examiner still has not addressed the fact that none of the cited references teach a data file comprising insurer information. Thus, even if the references were combined as suggested by the Examiner, such a combination would not result in Applicant's claimed invention as recited in claim 6.

Thus, for at least the reasons presented above, the rejection of claim 6 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 7, the cited art fails to teach or suggest the method of claim 1, further comprising further comprising shipping the item using the least expensive routing. Furthermore, the Examiner takes official notice that “it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice *in the context of Applicant’s claimed invention*. Applicant asserts that it was not well known in the prior art to ship items using the least expensive routing *wherein the item is accompanied by a memory device that stores a data file containing at least item information and insurer information*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, disclose shipping an item using the least expensive routing wherein the item is accompanied by a memory device that stores a data file containing insurer information. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, PIPinsure, Keuper, and the Examiner’s Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 7.

The Examiner, in the Response to Arguments, fails to provide any documentary evidence while still maintaining the rejection. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Applicants’ invention to ship items using the least expensive routing. There are many instance in which a more expensive routing may be used, such as to obtain faster shipping. Thus, even if shipping using the least expensive routing was known in other contexts, it was not known for the specific combination of limitations recited in claims 1 and 7. **Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner’s Official Notice.**

Thus for at least the reasons presented above, the rejection of claim 7 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 10, the cited art fails to teach or suggest the method of claim 1, wherein storing the data file comprises data in an XML format. Furthermore, the Examiner takes official notice that “it is old and well know within the computer arts to store data in eXtensible Markup Language (XML) format.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant asserts that it was not well known in the prior art to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, discloses that storing the data file comprises data in an XML format *where the data file is stored in a memory device that accompanies an item and where the data file includes at least item information and insurer information*. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, PIPinsure, Keuper, and the Examiner’s Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 10.

However, the Examiner, in the Response to Arguments, fails to provide any documentary evidence while still maintaining the rejection. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Applicant submits that Applicant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Applicants’ invention to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. XML may be known in the prior art for other purposes, but it is not used in the prior art for a data file

including the specific information recited in Applicant's claims and stored in a memory device accompanying an item being shipped. **Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice.**

Thus for at least the reasons presented above, the rejection of claim 10 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 11, the cited art fails to teach or suggest the method of claim 9, wherein the network data is exchanged in an XML format. Furthermore, the Examiner takes official notice that "it is old and well know within the computer arts to exchange network data in an XML format." Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner's taking of official notice in the context of Applicant's claimed invention. Applicant asserts that it was not well known in the prior art to exchange data in an XML format on a network *wherein the data includes at least item information and insurer information*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, discloses exchanging data including both item information and insurer information in an XML format on a network. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, PIPinsure, Keuper, and the Examiner's Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 11.

However, the Examiner, in the Response to Arguments, fails to provide any documentary evidence while still maintaining the rejection. Instead, the Examiner states, "Applicant's traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art" and "[a]s such, the features rejected via Official Notice are deemed to be admitted prior art." However, Applicant submits that Applicant adequately traversed the Examiner's taking of Official Notice and that it was not well known in the context of

Applicants' invention to exchange network data in an XML format. XML may be known in the prior art for other purposes, but it is not used in the prior art for the specific network data exchange recited in Applicant's claims. **Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice.**

Thus for at least the reasons presented above, the rejection of claim 11 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 19, Applicant asserts the rejection of claim 19 is unsupported by the cited art for at least reasons similar to those presented above in regard to claim 1. **Furthermore, Applicant asserts neither PIPinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a server connected to the memory device, wherein the server is configured to receive a request to insure the item being shipped from an origination to a final destination, search a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost, generate a data file comprising at least the following item information, and insurer information, and store the data file in the memory device that accompanies the item.** The Examiner asserts "Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, 9 and incorporated herein." The Examiner has improperly ignored the specific differences between the claim limitations of claims 1 and 19. Neither claims 1, 6, nor 9 - referred to by the Examiner in the rejection of claim 19 - recite a server configured as recited in claim 19. Furthermore, claims 6 and 9 recite limitations that are very different than the limitations of claim 19.

In the Response to Arguments, the Examiner fails to explain how the rejection of claim 19 addresses the differences between claims 1, 6, 9 and 19. Instead, the Examiner merely repeats the Examiner's speculation, unsupported by evidence or explanation, that the combination cited art, "does indeed teach and suggest Applicant's claimed features." Moreover, the Examiner's statement that the rejection of

claim 19 “substantially repeated the same limitations” as claims 1, 6 and 9, does not actually address the **actual differences** between the claims.

Additionally in regard to claim 19, the cited art also fails to teach or suggest a server configured to search a database for a cost effective insurance providing maximum insurance coverage for an item for the least cost. For example, the cited art of PIPinsure discloses a web form a user may fill out to request a savings quote. The Examiner also cites PIPinsure’s simple table of annual potential savings dependent on a declared package value and number of shipments per day. *A savings quote and a table of potential savings* have nothing to do with providing maximum insurance coverage for an item for the least cost as recited in claim 19. Furthermore, Keuper discloses a barrel tag transponder that stores data pertaining to the contents of the barrel. The cited art of Keuper has absolutely nothing to do with *insurance* much less providing maximum insurance coverage for an item for the least cost. Keuper and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. Additionally, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Thus, Kadaba, like Keuper, is absolutely silent in regard to item *insurance* much less providing maximum insurance coverage for an item for the least cost. Kadaba, Keuper, and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. The Examiner fails to address this argument in the Response to Arguments.

Thus for at least the reasons presented above, the rejection of claim 19 is unsupported by the cited art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 19 also apply to claim 20.

Applicants also assert that numerous other ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants respectfully submit that the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

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